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09/848,339	05/04/2001	Gideon Fostick	Q63704	6762

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EXAMINER
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DANIEL JR, WILLIE J

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/848,339

Applicant(s)

FOSTICK ET AL.

Examiner

Willie J. Daniel, Jr.

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6</u> .                                                                   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on 17 March 2004 is in compliance with the provisions of 37 CFR 1.97 and is being considered by the examiner.

### *Drawings*

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- a. **Fig. 2** has "ref. (1035) which is not included in specification.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

3. **Claim 21** is objected to because of the following informalities:

- a. Applicant omits ":" following the phrase "at least one of" in line 2 of the claim.

Examiner suggests using the phrase "**at least one of:**".

Appropriate correction is required.

4. The objection to the specification regarding hyperlinks is withdrawn, as the proposed specification correction is approved.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 27 and 42** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regards to Claims 27 and 42, Applicant claims “wherein undelivered SMS messages are deleted after expiration of a predetermined amount of time” which is not supported by <sup>the</sup> specification.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 20-21, 25, 28-29, 31, 33-36, 40, 43-44, 46-49** are rejected under 35 U.S.C. 102(b) as being anticipated by Takala (WO 99/53699).

Regarding **Claim 20**, Takala discloses a method of managing SMS messages (Fig. 1), comprising:

identifying an SMS message for a data terminal equipment (DTE) which reads on the claimed “message receiver” (see pg. 2, lines 18-21, 26-31; pg. 6, lines 10-21; pg. 7, lines 6-16; Fig. 1), where the short message service center (SMSC) provides receiving, delivering, or storing of short messages;

determining whether the message receiver (DTE) has set up at least one alternative handling instruction for calls which reads on the claimed “SMS messages” (see pg. 7, lines 14-28; pg. lines 3-9), where the user (hereinafter B-subscriber) sets up different fields in which identifiers correspond to particular A-subscribers to provide a short message; and

if it is determined that the message receiver (DTE) has set up an alternative handling instruction for SMS messages, then executing the alternative handling instruction, wherein the set up at least one alternative handling instruction includes a saving instruction for saving SMS messages in an electronic calendar (4) which reads on the claimed “personalized folder” for the message receiver (DTE) (see pg. 6, lines 12-36; pg. 7, lines 14-36), where the user

(hereinafter B-subscriber) sets up different fields in which specific identifiers are used to respond to different A-subscribers.

Regarding **Claim 21**, Takala discloses the method of claim 20, wherein the at least one alternative handling instruction additionally includes at least one of

a setting which reads on the claimed “filtering instruction” for filtering SMS messages identified for the message receiver (DTE) according to a predetermined criteria (see pg. 7, lines 20-32), where the user provides a setting for handling certain calls;

a forwarding instruction for forwarding an SMS message received by the message receiver to at least one additional address (see pg. 7, lines 20-24), where calls from certain numbers are to be connected to another number or terminal equipment; and

a deletion instruction for deleting SMS messages according to a predetermined criteria.

Regarding **Claim 25**, Takala discloses the method of claim 20, wherein the personalized folder (4) is a folder identified for saving urgent SMS messages (see pg. 6, lines 10-27; pg. 7, line 29 - pg. 8, line 9), where the system has a SMSC for storage of messages which communicates with the user’s calendar database (3) and electronic calendar (4). The saving of messages would be obvious for urgent or essential messages.

Regarding **Claim 28**, Takala discloses the method of claim 21, wherein there are a plurality of alternative handling instructions set up for the message receiver (DTE), and wherein a definition which reads on the claimed “content” of the SMS message is used to select the appropriate alternative handling instruction from the plurality of alternative handling instructions (see pg. 6, lines 12-36; pg. 7, lines 14-36), where the user has

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definitions that correspond to specific subscriber identifiers which provide different A-subscribers with information from the different fields.

Regarding **Claim 29**, Takala discloses the method of claim 20, wherein the at least one alternative handling instruction is set up via a form on a Web-based provisioning interface (DTE) (see pg. 6, lines 22-29; pg. 6, line 35 - pg. 7, line 13), where the user is able to provide database information for the instructions via software and internet protocols.

Regarding **Claim 31**, Takala discloses the method of claim 20, further comprising determining whether the message receiver (DTE) has set up at least one automatic response which reads on the claimed "AutoReply Message" for the message receiver (DTE) (see pg. 6, lines 16-21), where the user has an individualized message for A-subscriber.

Regarding **Claim 33**, Takala discloses the method of claim 31, wherein a content of the SMS message is used as the key to select the appropriate AutoReply Message from the plurality of AutoReply Messages (see pg. 6, lines 16-21; pg. 7, lines 31-36; pg. 8, lines 3-12), where the system uses content (e.g., definitions, identifiers, numbers, or addresses) to automatically respond with the appropriate information from the fields set up by the user.

Regarding **Claim 34**, Takala discloses the method of claim 31, wherein the appropriate AutoReply Message is selected in accordance with whether the SMS message is one of a Mobile-Originated SMS message and a machine originated SMS message (see pg. 6, lines 16-21,29-33; pg. 7, lines 3-36), where the system determines the response according to the fields and identifiers in which the data terminal equipment can be a mobile station or computer.

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Regarding **Claims 35-36**, these claims are rejected for the same reasons set forth above in Claims 20-21.

Regarding **Claim 40**, this claim is rejected for the same reasons set forth above in Claim 25.

Regarding **Claim 43**, this claim is rejected for the same reasons set forth above in Claim 28.

Regarding **Claim 44**, this claim is rejected for the same reasons set forth above in Claim 29.

Regarding **Claim 46**, this claim is rejected for the same reasons set forth above in Claim 31.

Regarding **Claim 47**, Lohtia discloses of wherein there are a plurality of AutoReply Messages set up for the message receiver (DTE), and wherein the SMS message is used as a key to select an appropriate AutoReply Message (see pg. 6, lines 16-21; pg. 7, lines 20-36), where the user has automatic responses to different identifiers which allows the delivering of different messages to the subscribers.

Regarding **Claims 48-49**, these claims are rejected for the same reasons set forth above in Claims 33-34.



***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 22, 23, 26, 27, 37, 38, 41, and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takala (WO 99/53699) in view of Alperovich et al. (hereinafter Alperovich) (US 6,101,393).

Regarding **Claim 22**, Takala teaches of wherein the at least one alternative handling instruction includes a filtering instruction specifying a predetermined criteria (see pg. 7, lines 20-36), where the user has settings for filtering messages received according to different fields and identifiers. Takala fails to disclose having an instruction by which SMS messages are to be rejected by the message receiver. However, the examiner maintains that to have an instruction by which SMS messages are to be rejected by the message receiver was well known in the art, as taught by Alperovich.

In the same field of endeavor, Alperovich teaches of have an instruction by which SMS messages are to be rejected by the MS (22) which reads on the claimed "message receiver" (see col. 5, line 22 - col. 6, line 6; Figs. 3-5), where the screening mechanism (200) rejects messages according to an SMS selective-delivery criteria.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Alperovich to have an instruction by which SMS messages are to be rejected by the message receiver, in order to

selectively deliver messages from identifiers of a selection and rejection lists, as taught by Alperovich.

Regarding **Claim 23**, Takala teaches of wherein said filtering instruction (see pg. 7, lines 20-36), where the user has settings for filtering messages received according to different fields and identifiers. Takala fails to disclose to have an instruction that rejects SMS messages that are older than a predetermined amount of time. However, the examiner maintains that to have an instruction that rejects SMS messages that are older than a predetermined amount of time was well known in the art, as taught by Alperovich.

Alperovich further teaches of have an instruction that rejects SMS messages that are older than a predetermined delivery-delay period which reads on the claimed "amount of time" (see col. 4, line 57 - col. 5, line 3; Figs. 3-5), where the screening mechanism (200) rejects messages according to an SMS selective-delivery criteria.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Alperovich to have an instruction that rejects SMS messages that are older than a predetermined amount of time, in order to selectively deliver messages from identifiers of a selection and rejection lists, as taught by Alperovich.

Regarding **Claim 26**, Takala teaches of wherein at least one alternative handling instruction (see pg. 7, lines 20-36), where the user has settings for distributing specific messages according to different fields and identifiers. Takala fails to disclose having an instruction that includes a deletion instruction for deleting undelivered SMS messages. However, the examiner maintains that having an instruction that includes a deletion

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instruction for deleting undelivered SMS messages was well known in the art, as taught by Alperovich.

Alperovich further teaches of having an instruction that includes a deletion instruction for deleting undelivered SMS messages (see col. 4, line 57 - col. 5, line 3; Figs. 3-5), where the screening mechanism (200) deletes messages that are undelivered according to an SMS selective-delivery criteria.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Alperovich to have an instruction that includes a deletion instruction for deleting undelivered SMS messages, in order to selectively deliver messages from identifiers of a selection and rejection lists, as taught by Alperovich.

Regarding **Claim 27**, Takala fails to disclose wherein undelivered SMS messages are deleted after expiration of a predetermined amount of time. However, the examiner maintains that wherein undelivered SMS messages are deleted after expiration of a predetermined amount of time was well known in the art, as taught by Alperovich.

Alperovich further teaches of wherein undelivered SMS messages are deleted after expiration of a predetermined amount of time (see col. 4, line 57 - col. 5, line 3; Figs. 3-5), where the screening mechanism (200) deletes messages that are undelivered according to SMS selective-delivery criteria.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Alperovich to have wherein undelivered SMS messages are deleted after expiration of a predetermined amount of time, in

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order to selectively deliver messages from identifiers of a selection and rejection lists, as taught by Alperovich.

Regarding **Claims 37-38**, these claims are rejected for the same reasons set forth above in Claims 22-23.

Regarding **Claims 41-42**, these claims are rejected for the same reasons set forth above in Claims 26-27.

**Claims 24 and 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takala (WO 99/53699) in view of Patil (US 6,625,460 B1).

Regarding **Claim 24**, Takala teaches of wherein the at least one alternative handling instruction includes a forwarding instruction for forwarding a received call which reads on the claimed "SMS message" (see pg. 7, lines 20-24), where the call is directed to another number. Takala fails to disclose having an instruction for forwarding a received SMS message to a plurality of different addresses. However, the examiner maintains that having an instruction for forwarding a received SMS message to a plurality of different addresses was well known in the art, as taught by Patil.

In the same field of endeavor, Patil teaches of having an instruction for forwarding a received SMS message to a distribution list which reads on the claimed "plurality of different addresses" (see col. 4, line 27 - col. 5, line 32; col. 6, lines 37-47; Figs. 3 and 5), where the user of the SM program has messages forwarding to the addresses of the distribution list.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Patil to have an instruction

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for forwarding a received SMS message to a plurality of different addresses, in order to provide messages of information to recipients of a distribution list, as taught by Patil.

Regarding **Claim 39**, the claim is rejected for the same reasons set forth above in Claim 24.

**Claims 30, 32, and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takala (WO 99/53699) in view of Lohtia et al. (hereinafter Lohtia) (US 6,560,456 B1).

Regarding **Claim 30**, Takala teaches of wherein the at least on alternative handling instruction is set up (see pg. 6, lines 22-29; pg. 6, line 36 - pg. 7, line 12; pg. 7, lines 20-24), where the user is able to provide settings for instruction via the data terminal equipment using software and the internet to control the databases. Takala fails to disclose having an instruction that is set up via an SMS message. However, the examiner maintains that having an instruction that is set up via an SMS message was well known in the art, as taught by Lohtia.

In the same field of endeavor, Lohtia teaches of having a request which reads on the claimed "instruction" that is set up via an SMS message (see abstract; col. 4, lines 22-39; 51-56; col. 4, line 66 - col. 5, line 5; col. 5, line 44 - col. 6, line 5; Figs. 1-4), where the user of the handset (11) has a profile that allows the user to make a request via a SMS origination message which has a telephone number or code that acts as a trigger for receiving the requested information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Lohtia to have an instruction

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that is set up via an SMS message, in order to have requested information delivered to a user according to the user's profile, as taught by Lohtia.

Regarding **Claim 32**, the combination of Takala and Lohtia discloses everything claimed, as applied above (see claim 30), in addition Takala further teaches of wherein there are a plurality of AutoReply Messages set up for the message receiver (DTE), and wherein the SMS message is used as a key to select an appropriate AutoReply Message (see pg. 6, lines 16-21; pg. 7, lines 20-36), where the user has automatic responses to different identifiers which allows the delivering of different messages to the subscribers.

Regarding **Claim 45**, this claim is rejected for the same reasons set forth above in Claim 30.

***Response to Arguments***

8. Applicant's arguments with respect to claims 20-49 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willie J. Daniel, Jr. whose telephone number is (703) 305-8636. The examiner can normally be reached on 7:30-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WJD,JR/wjd,jr  
21 May 2004

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**